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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,177	06/27/2001	Michael S. Ripley	42390P11151	4529
<div>7590 09/26/2007 BLAKELY, SOKOLOFF, TAYLOR &amp; ZAFMAN LLP Seventh Floor 12400 Wilshire Boulevard Los Angeles, CA 90025-1026</div>			<div>EXAMINER LANIER, BENJAMIN E</div>	
			<div>ART UNIT 2132</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 09/26/2007</div>	<div>DELIVERY MODE PAPER</div>

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<p align="center"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p>09/893,177</p>	<p><b>Applicant(s)</b></p> <p>RIPLEY ET AL.</p>	
	<p><b>Examiner</b></p> <p>Benjamin E. Lanier</p>	<p><b>Art Unit</b></p> <p>2132</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-8, 19, 20, 31-33 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-8, 19, 20, 31-33 and 37-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

#### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07 September 2007 has been entered.

#### ***Response to Amendment***

2. Applicant's amendment filed 07 September 2007 amends claims 6, 19, and 31. Applicant's amendment has been fully considered and entered.

#### ***Response to Arguments***

3. Applicant's argument that Saito does not store the encrypted content and encrypted title key in a non-volatile memory has been fully considered and is persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hirano, U.S. Patent No. 7,145,492.

#### ***Claim Objections***

4. Claim 37 is objected to because of the following informalities: "suing" on the last line of claim 37 should be changed to "using". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. Claims 19, 20, 31-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 19, 20, 31-33 are drawn to a machine-readable medium that is described in the specification as being a carrier wave (Page 5, [0015]). Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in §101 (Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility Annex IV, Oct. 26, 2005, at [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf), 1300 OG 142 (Nov. 22, 2005)).

7. The Supreme Court has read the term “manufacture” in accordance with its dictionary definition to mean “the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.” Diamond v. Chakrabarty, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting American Fruit Growers, Inc. v Brogdex Co., 283 U.S. 1, 11, 8 USPQ 131, 133 (1931), which in turn, quotes the Century Dictionary). Other courts have applied similar definitions. See American Disappearing Bed Co. v. Arnaelsteen, 182 F.324, 325 (9<sup>th</sup> Cir. 1910), cert. denied, 220 U.S. 622 (1911). These definitions require physical substance, which a claimed signal does not have. Congress can be presumed to be aware of an administrative or judicial interpretation of a statute and to adopt that interpretation when it re-enacts a statute without change. Lorillard v.

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Pons, 434 U.S. 575, 580 (1978). Thus, Congress must be presumed to have been aware of the interpretation of manufacture in American Fruit Growers when it passed the 1952 Patent Act.

8. A manufacture is also defined as the residual class of product. 1 Chisum, §1.02[3] (citing W. Robinson, The Law of Patents for Useful Inventions 270 (1890)). A product is a tangible physical article or object, some form of matter, which a signal is not. That the other two products classes, machine and composition of matter, require physical matter. A signal, a form of energy, does not fall within either of the two definitions of manufacture. Thus, a signal does not fall within one of the four statutory classes of §101.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 6, 7, 19, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hirano, U.S. Patent No. 7,145,492. Referring to claims 6, 19, Hirano discloses a content distribution system wherein a user provides user id information with a request for content (Col. 5, lines 22-28), which meets the limitation of receiving a request to transfer content to a customer, obtaining a customer identifier (I.D.) associated with the customer. The requested content is encrypted with a content key (Col. 5, lines 18-20), which meets the limitation of retrieving from a content source encrypted content corresponding to the requested content, the encrypted content being encrypted by a title key. The content key is then encrypted using the user id information (Col. 5, lines 29-

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30), which meets the limitation of binding the requested content to the customer I.D. by using the customer I.D. to encrypt the title key. The encrypted content and encrypted content key can be transmitted to the requesting user for storage are recorded on a CD-ROM or DVD for distribution to the requesting user (Col. 6, lines 9-14), which meets the limitation of transferring from the content source the encrypted content and the encrypted title key to a non-volatile storage medium, and storing the encrypted content and the encrypted title key on the non-volatile storage medium, from which the encrypted content and the encrypted title key may be accessed by the customer.

Referring to claims 7, 20, Hirano discloses that the content key is encrypted using the user id information and a secret key (Col. 5, lines 29-30), which meets the limitation of combining the customer I.D. with a media key provided by the content source.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirano, U.S. Patent No. 7,145,492, in view of Vanstone, U.S. Patent No. 6,487,661. Referring to claim 8, Hirano discloses that both the user id information and secret key are used to encrypt the content key (Col. 5, lines 29-30). Hirano does not disclose that the user id information and secret key are hashed together to create a key that encrypts the content key. Vanstone discloses a key generation method that hashes identification information and a session key to create a shared key (Abstract & Col. 3, lines 8-44), which meets the limitation of combining the customer I.D. with a media key comprises using a cryptographic one-way function. It would have been obvious to one of ordinary skill in the art at the time the invention was made to hash the user id information with the secret key and use the hash to encrypt the content key in order to prevent unauthorized access to the key that encrypts/decrypts the content key as suggested by Vanstone (Col. 3, lines 45-49).

14. Claims 31, 33, 37, 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirano, U.S. Patent No. 7,145,492, in view of Lotspiech, U.S. Patent No. 6,883,097. Referring to claims 31, 33, 37, 39, Hirano discloses that the encrypted content and encrypted content key can be transmitted to the requesting user for storage are recorded on a CD-ROM or DVD for distribution to the requesting user (Col. 6, lines 9-14), which meets the limitation of access from a non-volatile storage medium content encrypted with a title key accessible by a customer, the non-volatile storage medium additionally storing a customer I.D. associated with the customer requesting the content. The content key is encrypted using the user id information (Col. 5, lines 29-30), which meets the limitation of the title key is encrypted with a customer I.D. The user id information and the secret key are used to decrypt the content key (Col. 6, lines 65-67), which meets the limitation of decrypting the encrypted title key to form the title key by reading a

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customer I.D., and combining the customer I.D. and the media key. The encrypted content is decrypted using the decrypted content key (Col. 7, lines 1-3), which meets the limitation of using the title key to decrypt the encrypted content. Hirano does not disclose that the secret key is obtained from a media key block, contained within the storage medium, using device keys associated with the device for using the content. Lotspiech discloses a content distribution system wherein the key used to encrypt the audio content (Col. 1, line 40) (media key in Lotspiech) is included in a media key block in the storage medium along with the encrypted content, and the media key is access by decrypting the media key block with device keys of the accessing device (Col. 4, lines 17-24), which meets the limitation of processing the MKB to generate a media key by using device keys associated with a device for using the content, the content comprises a music title. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the secret key of Hirano to be included in the storage medium along with the content in a media key block such that the secret key could be accessed by using the device keys of the accessing device on the media key block in order assist in the prevention of content piracy (Lotspiech: Col. 1, lines 20-22) by complicating coincidence attacks (Lotspiech: Col. 2, lines 11-18).

15. Claims 32, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirano, U.S. Patent No. 7,145,492, in view of Lotspiech, U.S. Patent No. 6,883,097 as applied to claims 31, 37 above, and further in view of Vanstone, U.S. Patent No. 6,487,661. Referring to claims 32, 38, Hirano discloses that both the user id information and secret key are used to encrypt the content key (Col. 5, lines 29-30). Hirano does not disclose that the user id information and secret key are hashed together to create a key that encrypts the content key. Vanstone discloses a key



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generation method that hashes identification information and a session key to create a shared key (Abstract & Col. 3, lines 8-44), which meets the limitation of combining the customer I.D. with a media key comprises using a cryptographic one-way function. It would have been obvious to one of ordinary skill in the art at the time the invention was made to hash the user id information with the secret key and use the hash to encrypt the content key in order to prevent unauthorized access to the key that encrypts/decrypts the content key as suggested by Vanstone (Col. 3, lines 45-49).

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805. The examiner can normally be reached on M-Th 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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